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In re Application of:

HOFMANN, Albrecht, et al.

U.S. Application No.: 10/511,285

PCT No.: PCT/DE03/01079

International Filing Date: 02 April 2003

Priority Date: 18 May 2002

Attorney's Docket No.: 2998

For: SYSTEM COMPRISING A TOOL RETAINER

COMMUNICATION
REGARDING SUBMISSION
UNDER 37 CFR 1.42

This communication is issued in response to applicants' submission on 14 October 2004 of a declaration that identifies one of the inventors as deceased. The submission is treated herein as a submission under 37 CFR 1.42.

BACKGROUND

On 02 April 2003, applicants filed international application PCT/DE03/01079 which claimed a priority date of 18 May 2002 and which designated the United States. On 27 November 2003, a copy of the international application was communicated to the United States Patent And Trademark Office ("USPTO") by the International Bureau ("IB"). The deadline for payment of the basic national fee was thirty months after the priority date, i.e. 18 November 2004.

On 14 October 2004, applicant filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee, a translation of the international application into English, and a declaration executed by three of the four inventors. The declaration included an unsigned signature block for the remaining inventor, Markus HECKMAN, with a handwritten statement that this inventor had died.

DISCUSSION

37 CFR 1.42 states, in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

Section 409.01(a) of the Manual of Patent Examining Procedure (MPEP) states that the application can also be executed by all of the heirs of the deceased inventor, where no legal representative has been appointed or is required to be appointed by law.

37 CFR 1.497(b)(2) states the following:

(2) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47) the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

Pursuant to 37 CFR 1.497(b)(2), the citizenship, mailing address, and residence information for **both** the deceased inventor and the legal representative (or all the heirs, if applicable) must be included in the declaration.

The declaration filed by applicants on 14 October 2004 does not comply with 37 CFR 1.42 and 1.497(b)(2) in that it has not been executed on behalf of the deceased inventor by the deceased inventor's legal representative (or by all the heirs of the deceased inventor, if appropriate). Accordingly, the declaration cannot be accepted under 37 CFR 1.497 and 1.42.

CONCLUSION

For the reasons discussed above, the request for status under 37 CFR 1.42 is **DISMISSED** without prejudice.

Applicants have **TWO (2) MONTHS** from the mailing date of this communication to submit a proper response under 37 CFR 1.42 and 37 CFR 1.497. Failure to provide a proper and timely response will result in abandonment.

Extensions of time are available under 37 CFR 1.136(a).

A proper response must include an oath or declaration executed on behalf of the deceased inventor in compliance with 37 CFR 1.42 and including all the information required under 37 CFR 1.497 (for example, the names of all the inventors and the citizenship, mailing address, and residence information for **both** the deceased inventor and the legal representative, as discussed above).

Applicants must also provide the \$130 surcharge for filing an acceptable declaration later than thirty months after the priority date.

Any further correspondence with respect to this matter should be addressed to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration

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